

REMARKS

Reconsideration of this application is respectfully requested. Claims 1-22 are pending in this application. Claims 1-20 are allowed. Claim 21 stands rejected. Claim 22 was withdrawn from consideration as being directed to a non-elected invention.

Claim Rejection-35 U.S.C. §112, first paragraph

Claim 21 is rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the *written* description requirement. For the reasons set forth in detail below, this rejection is respectfully traversed.

The Office Action asserts that the claimed *“receiver having a first mode of operation for storing in the memory the receiving conditions of each of the plurality of broadcasting waves at a time of adjusting an antenna used for receiving the broadcasting wave, and a second mode of operation in which the receiving conditions of a broadcasting wave, during viewing of the broadcasting wave at a time subsequent to the storing of receiving conditions in the first mode”* is not described in the specification, the drawings or the original claims in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, has possession of the claimed invention.

Initially, a brief summary of the requirements of 35 U.S.C. §112, first paragraph, will be set forth below. 35 U.S.C. §112, first paragraph, states “The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or

with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.”

Initially, it is noted that courts have interpreted 35 U.S.C §112, first paragraph, to have three (3) requirements. Specifically, (1) the written description requirement, (2) the enablement requirement, and (3) the best mode requirement. The written description requirement ensures that the applicant had in his or her possession, as of the filing date of the application, the specific subject matter claimed by the applicant. In other words, to satisfy the written description requirement, there must be some written description of the claim element(s) in the specification.

Further, the applicant's specification need not describe the claimed invention *explicitly* in order to comply with the written description requirement. More specifically, the test for determining whether a claimed invention is adequately described in the specification is whether the originally filed disclosure *reasonably* conveys to a person having ordinary skill in the art that the applicant had possession of the subject matter later claimed.

The Court of Appeals for the Federal Circuit has held that to satisfy the written description requirement, it is not necessary that the application describe the claim limitations *exactly*, but *only so clearly that persons of ordinary skill in the art to which the invention pertains would recognize from the disclosure that the applicant's invention included those limitations*.

An assertion that there is no written description can be overcome by showing that the missing description is *implicit* in the specification. For example, an assertion that there is no written description can be overcome if applicants can show that the limitation is logically

inferred by those skilled in the art from that which is disclosed, both in the specification and the drawings.

As noted above, the written description requirement of 35 U.S.C. §112, first paragraph, is met if the specification either explicitly or implicitly provides a written description of the claimed invention.

In this case, the present specification *explicitly* discloses the claimed “*receiver having a first mode of operation for storing in the memory the receiving conditions of each of the plurality of broadcasting waves at a time of adjusting an antenna used for receiving the broadcasting wave, and a second mode of operation in which the receiving conditions of a broadcasting wave, during viewing of the broadcasting wave at a time subsequent to the storing of receiving conditions in the first mode....*”

More specifically, a written description of the claimed “*receiver having a first mode of operation for storing in the memory the receiving conditions of each of the plurality of broadcasting waves at a time of adjusting an antenna used for receiving the broadcasting wave*” is clearly provided, e.g., in section [0035] of the application specification, and specifically on page 17, lines 10-23.

In particular, page 17, lines 10-14 of the specification discloses “The CPU 23 automatically detects the receiving condition (the frequency of error correction) for each broadcasting wave, and stores the results thereof in the memory 24. This processing shall be performed when the antenna is adjusted.” Further, page 17, lines 21-23 of the specification states

“By this processing, the receiving condition for each broadcasting wave at the time of adjusting the antenna is grasped.”

Further, a written description of the claimed “*receiver having ...a second mode of operation in which the receiving conditions of a broadcasting wave, during viewing of the broadcasting wave at a time subsequent to the storing of receiving conditions in the first mode is compared with [the receiving condition stored in the memory during the first mode of operation]*” is clearly provided, e.g., in section [0035] of the specification, and specifically on page 17, line 23 – page 18, line 19.

More particularly, page 17, lines 23-25 of the specification discloses “After the antenna is adjusted, the receiving condition of broadcasting waves during viewing is detected.” Further, page 18, lines 6-11 of the specification states “The detected receiving condition and the results of the detection at the beginning of the adjustment of the antenna stored in memory 24 are compared with each other. It is judged whether or not the receiving condition of the broadcasting wave is liable to be degraded on the basis of the results of the comparison.”

In view of the portions of the specification pointed out above, it is submitted that the specification clearly provides an explicit written description of the claimed “*receiver having a first mode of operation ..., and a second mode of operation ...*” in accordance with the requirements of §112, first paragraph.

Accordingly, reconsideration and withdrawal of the rejection of claim 21 under 35 U.S.C §112, first paragraph, are respectfully requested.

Application No. 09/930,129
Art Unit: 2611

Request for Reconsideration under 37 C.F.R. §1.116
Attorney Docket No.: 042204

CONCLUSION

In view of the foregoing, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



William M. Schertler
Attorney for Applicants
Registration No. 35,348
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

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